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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,495	11/24/2003	Kathryn Gregory	GREG-1 CIP 3	4576
7590 11/14/2005			EXAMINER	
Mark J. Pandiscio Pandiscio Pandiscio, P.C. 470 Totten Pond Road Waltham, MA 02451-1914			MORAN, KATHERINE M	
			ART UNIT	PAPER NUMBER
			3765	

DATE MAILED: 11/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/720,495

**Applicant(s)**

GREGORY, KATHRYN

**Examiner**

Katherine Moran

**Art Unit**

3765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 16-20 is/are rejected.
- 7) ☒ Claim(s) 14 and 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 20 is objected to because of the following informalities: claim 20 is redundant because its claim limitations are previously outlined in claims 1 and 18. Appropriate correction is required.

### ***Specification***

2. The disclosure is objected to because of the following informalities: pg.2, line 9: insert --now abandoned,-- after "reference),". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 4 contains the trademark/trade name Lycra. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is

used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe spandex and, accordingly, the identification/description is indefinite.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 6-8, 10, 11, 16, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Samuels (U.S. 3,416,518) in view of Williams (U.S. 5,415,624). Samuels discloses the invention substantially as claimed. Samuels teaches an article 10 of thermal clothing for covering an underlying area at a gap between a coat sleeve and a glove, the article comprising a tube having a distal portion terminating in a distal end 12, and a side opening 16 formed in the distal portion adjacent to but spaced from the stitched distal end 12, the tube being formed out of a fabric that is flexible and stretchable, wherein the fabric retains a memory of the shape of a wearer's hand and forearm so that after repeated uses by the wearer, the tube tends to be form fitting. The tube is sized so that it can be snugly fit over the wearer's hand and forearm so that the distal end 12 of the tube is positioned near a midpalm area of the hand and the proximal end 14 of the tube is positioned at a forearm area, with the wearer's thumb extending

out through the tube's side opening 16. Side opening 16 is formed substantially transverse to a longitudinal axis of the tube in that the opening has a transverse, in addition to a longitudinal, dimension. However, Samuels does not teach a pocket fixed to the tube and open at a selected end to receive a selected article. Williams teaches a tubular article 14 worn on the hand and arm, with the article including a pocket 32 or 34 fixed to the tube and open at a proximal end thereof to receive a warming device 40 or 42 sized to be retained by the pocket.

7. Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Samuels in view of Williams as applied to claim 1 above, and further in view of Donner (U.S. 6,449,772). Samuels, when viewed with Williams as outlined above, discloses the invention substantially as claimed. However, Samuels doesn't teach that the fabric comprises a fleece-type knitted polyester comprising a circular construction so as to form an extremely tight knit fabric, and further comprising nylon. Donner teaches a sleeve 10 formed of fleece fabric (inherently includes a polyester component) and also teaches that the sleeve could include nylon. The fabric is capable of providing good thermal insulation without providing skin stimulation therapy to skin coming into contact with the tube, with the tube sized so that it can be snugly fit over the wearer's hand and forearm without providing therapeutic compression thereto. It is noted that Applicant has not provided specific dimensions for the sleeve's size and that the fit of the sleeve also depends upon the dimensions of the person's hand and arm upon which it is worn. Thus, the degree of skin contact and compression is not measurable and does not hold patentable weight in interpreting the claim. Therefore, it would have been obvious to

form Samuels' sleeve from a fleece type polyester including nylon since these materials are known for their comfort and resiliency properties.

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Samuels in view of Williams as applied to claim 1 above, and further in view of Girest (U.S. 3,837,007). Samuels, when viewed with Williams as outlined above, discloses the invention substantially as claimed. However, Samuels doesn't teach reflective means positioned on at least the portion of the tube disposed in a gap between the coat sleeve and the glove. Girest teaches a sleeve 10 with reflective means 11 extending along the sleeve's length. Therefore, it would have been obvious to provide Samuels' device with the reflective means as taught by Girest, in order to increase the visibility of the wearer under dark or poorly lit conditions.

9. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Samuels in view of Williams as applied to claim 1 above, and further in view of Berger (U.S. 4,531,241). Samuels, when viewed with Williams as outlined above, discloses the invention substantially as claimed. However, Samuels doesn't teach that the tube further includes a relatively durable material, leather, fastened to a portion of the tube's distal portion and disposed on the midpalm area. Berger teaches a tube 10 including a leather portion 14 which protects those areas of the tube which are more exposed to wear and tear. Therefore, it would have been obvious to one of ordinary skill in the art to provide Samuels' tube with leather, as taught by Berger, to extend the life of the tube and allow for longer wear.

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10. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Samuels '518 in view of Girest '007. Samuels disclose the invention substantially as claimed. However, Samuels doesn't teach reflective means positioned on the tube between the proximal end and the side opening adjacent the wearer's wrist. Girest teaches this feature as outlined above.

#### ***Allowable Subject Matter***

11. Claims 14 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

12. The prior art made of record on the attached PTO-892, and not relied upon, is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications should be directed to Primary Examiner Katherine Moran at (571) 272-4990. The examiner can be reached on Monday-Thursday from 8:30 am to 6:00 pm, and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert, may be reached at (571) 272-4983. The official and after final fax number for the organization where this application is assigned is (571) 273-8300. General information regarding this application may be obtained by contacting the Group Receptionist at (571) 272-3700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kmm

November 8, 2005

A handwritten signature in black ink, appearing to read 'K Moran', with a stylized flourish at the end.

Katherine Moran

Primary Examiner, AU 3765